

**REMARKS**

Claims 5-13 are now pending in this application. Claims 1-5 are rejected. Claims 1-5 are cancelled herein. New claims 6-13 are added.

Applicant herein traverses and respectfully requests reconsideration of the rejection of the claims cited in the above-referenced Office Action.

Claims 1-5 are cancelled herein in favor of new claims 6-14, which are substituted therefor. While the cancellation of claims 1-5 renders all rejections of record moot, to the extent that the subject matter of new claims 6-14 reflects an overlap with any of the cancelled claims 1-5, and in the event the Examiner considers asserting the present rejection against the new claims or making the next Office Action final, applicant submits the following remarks. Applicant respectfully submits that the new claims are patentable over the cited art of record based upon their claimed subject matter as discussed more fully below.

Claims 1-5 are rejected as indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention as a result of informalities stated in the Office Action. The claims are now cancelled rendering said rejection moot. New claims 6-13 have been drafted in consideration of the bases of the prior rejections of claims 1-5, and avoid all indefinite issues noted in the Office Action.

Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being anticipated by McCloskey (US 4,450,703). As noted above, the cancellation of claims 1-3 renders the claim rejections moot. It is respectfully submitted that McCloskey fails to anticipate new claims 6-13.

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim* .” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). It is respectfully submitted that the cited reference is deficient with regard to the following.

Each of the independent claims 6 and 7 describes a process which includes placing an intermediate product, which has been heated to a plasticity temperature, so as to be held coaxially on a first forming tool having on a pressing face thereof, recesses or holes that are arranged in a rotational symmetry of predetermined angle around a center axis thereof. A second forming tool, having on a pressing face thereof, one or more projections only within a certain angular region about a corresponding center axis, is then positioned relative to the first forming tool, so as to be coaxial with the first forming tool and so that each of the projections is positioned to match one of the recesses or holes. A portion of the discoid part is then pressed by thrusting the second forming tool relative to the first forming tool, followed by which, the second forming tool is retreated relative to the first forming tool after the pressing. The first forming tool is rotated around its center axis by the

predetermined angle, relative to the second forming tool, after the retreating. By repeating the pressing, the retreating and the rotating, the pressing is made for every one of the recesses or holes on the first forming tool.

It is respectfully submitted that no such teaching or suggestion is present in McCloskey. Rather, McCloskey merely discloses an eight place indexing table (8-station rotary table) and its use for producing a "rod end" that has a ring-shaped "head portion 4" and a "threaded bore 12". McCloskey is not related to "the portion-by-portion-wise forging" nor to the rotation of the forming tool about its axis. In McCloskey, a work piece positioned on a fringe of a rotary table revolves circumferentially along with corresponding rotation of the rotary table. The work piece itself, as well as an "upper die 22" and a "lower die 34" of the "die press 20," never rotate nor revolve about their corresponding center axes. In McCloskey, the "axial opening 54" on the "head portion 4" is formed by two-stage process of pressing by the "die press 20" shown in Fig.5 and punching by the "die punch 56" shown in Fig.7 (see col. 4, line 35- col. 5, line 42) at separate processing sections arranged sequentially in various circumferential positions around the indexing table (See col. 3, lines 56-61).

In view of the above, it is respectfully submitted that new claims 6-13 particularly describe and distinctly claim elements not disclosed in the cited reference. Their allowance is respectfully requested.

Claim 5 is rejected under 35 U.S.C. § 102(b) as being anticipated by Kato et al (US 5,092,040). Claim 5 is cancelled, rendering the rejection moot. Additionally, since Kato merely discloses a one-piece wheel in which a disk and a rim are integrally formed by forging of metal material, the disclosure therein which involves forming the wheel by conducting a "spin molding process" by use of a "pressing device 2" and a pair of "mandrels 11, 12," is entirely unrelated to "the portion-by-portion-wise forging" or to the approach utilizing rotation of the forming tool about its center axis, as claimed.

Applicant respectfully requests a one (1) month extension of time for responding to the Office Action. Please charge the fee of \$120 for the extension of time to Deposit Account No. 10-1250.

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form  
for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,  
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